

4/18/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 10

HRW

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Konica Photo Imaging, Inc.

Serial No. 75/872,247

Joel E. Lutzker of Schulte Roth & Zabel LLP for Konica Photo Imaging, Inc.

Edd Vasquez, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Wendel and Drost, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Konica Photo Imaging, Inc. has filed an application to register PHOTO STATIONERY for "photofinishing services."<sup>1</sup>

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark would be merely descriptive, if used in connection with

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<sup>1</sup> Serial No. 75/872,247, filed December 15, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

applicant's recited services. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs.<sup>2</sup> An oral hearing was not requested.

The Examining Attorney maintains that the term PHOTO STATIONERY, as applied to applicant's services, is merely descriptive in that it conveys the information to consumers that applicant is providing photofinishing services in which photographs are made into stationery. As such, the Examining Attorney argues, the term immediately describes the nature and purpose of the services.

To support this position, the Examining Attorney has introduced both dictionary definitions of the words "photo" and "stationery"<sup>3</sup> and excerpts of articles retrieved from the Nexis database showing use of the term "photo stationery."

As examples we note:

Her hobbies were sports, reading and photography; for many years she gave book reviews and created distinctive photo stationery.  
*The Stuart News/Port St. Lucie News* (Jan. 9, 1998);

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<sup>2</sup> Applicant has attached supplementary material to its reply brief. Pursuant to Trademark Rule 2.142(d) the record should be complete prior to the filing of an appeal. The Board will ordinarily not consider additional evidence filed by an applicant after the appeal has been filed. Accordingly, no consideration has been given to this material.

<sup>3</sup> The word "photo" is defined as being the informal form of the word "photograph" and "stationery" as "writing paper and envelopes." *The American Heritage Dictionary of the English Language* (3<sup>rd</sup> ed. 1992).

Is there a future for a technology that lets you see shots instantly on a TV or a PC, print only the best, and even design your own photo stationery?  
*San Antonio Express-News* (Oct. 4, 1996);

After coming up with endless ways of collecting, keeping and displaying photographs, Mr. Bourne launched his mail-order business. Exposures offers photo restoration, the standard fare of picture frames, photo albums and scrapbooks, as well as photo stationery, jigsaw puzzles...  
*The New York Times* (Feb. 7, 1988).

The Nexis articles are specifically relied upon by the Examining Attorney as evidence that the term "photo stationery" is a term recognizable to consumers and used by the general public in reference to a specific type of goods.

Applicant argues that PHOTO STATIONERY is not merely descriptive of applicant's services "because of the circuitous reasoning required by prospective customers to realize that Applicant's services are photo finishing services." (Brief p. 2-3). While applicant acknowledges that its mark contains elements which may be descriptive in and of themselves, applicant insists that when its mark is considered in its entirety, PHOTO STATIONERY is no more than suggestive and does not specifically describe any precise characteristic of photofinishing services. Applicant contends that the words PHOTO and STATIONERY are "seemingly incompatible" in that paper on which one writes

which also contains a photograph is the "antithesis of conventional stationery." (Brief p. 7).

Applicant further argues that it is unaware of others using the term "photo stationery" to describe photofinishing services and the Examining Attorney has produced no evidence of use of the term by competitors. Applicant challenges the Nexis evidence produced by the Examining Attorney, asserting, inter alia, that the articles do not show use of the term "photo stationery" in a manner consistent with providing photofinishing services, and that the articles do not describe the nature of "photo stationery" nor suggest that such stationery is a recognizable good in commerce.

Finally, applicant argues that if there is any doubt as to whether applicant's mark is suggestive or merely descriptive, this doubt should be resolved in favor of applicant.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used, or is intended to be used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely

descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

As pointed out above, the issue of mere descriptiveness is not determined in the abstract, but rather in relation to the particular goods or services with which the mark is being used. Thus, the question is not whether the term PHOTO STATIONERY would in itself convey the information to consumers that applicant provides photo-finishing services. Instead the question is whether, as used in connection with photofinishing services, the term immediately and directly conveys information to consumers as to a particular feature or characteristic of these photo

finishing services, such that it is merely descriptive of this particular aspect of the services.

Here the dictionary definitions alone show that the term "photo stationery" has a readily recognizable meaning, namely, stationery or writing paper containing photographs. We find no incompatibility in the combination of these two words; many types of stationery are decorated in some way with a design yet still serve as writing paper.

In addition, the Nexis excerpts demonstrate that the term has appeared in articles directed to the U.S. public and used in such a manner that the term would be understood to convey the ordinary meaning resulting from the combination of the dictionary definitions of the two separate words. In other words, "photo stationery" would be understood as just that, stationery containing photographs. While these articles may refer to the creation of "photo stationery" by individuals, rather than any large scale commercialization of providing such a product, they still serve to demonstrate public familiarity with a product of this nature. Whether or not other photo-finishing businesses provide such a product or use this term to describe a comparable product, we find the term "photo stationery" immediately conveys information to the purchasing public as to this particular feature of

**Ser No.** 75/872,247

applicant's photofinishing services, i.e., the providing of photographs in the form of stationery. There is no circuitous reasoning required for consumers to reach such a conclusion as to the nature of applicant's services.

Accordingly, we find PHOTO STATIONERY would be merely descriptive, if used as intended with applicant's photofinishing services.

Decision: The refusal to register under Section 2(e)(1) is affirmed.